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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,324	09/16/2003	Tetsuya Kanekon	030192A	9165
38834 7590 09/19/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
LOFTUS, ANNE				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/662,324

Applicant(s)

KANEKON, TETSUYA

Examiner

ANN LOFTUS

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 3/4/2008.

DETAILED ACTION

Status of the Claims

1. This action is in response to an amendment filed on 6/5/08. Claims 1-3, and 6-17 are pending. Claims 4 and 5 are cancelled.

Priority

2. This application was filed 9/16/03. Its oath claims foreign priority from Japanese Patent 2002-275073 dated 9/20/02. A certified copy and a translation are now present in the record.

Response to Arguments

3. Applicant's arguments with respect to claim have been considered but are moot in view of the new ground(s) of rejection.

The examiner notes that it was old and well-known at the time of the invention to make units from known functionality and put the units together on a server. This requires common knowledge of server operating systems, install methods and combination testing. This knowledge is not included in the specification, presumably because a person of ordinary skill in the art would have known how to use this knowledge to collect these units and configure them to run together on a server.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-3, 6, 7, 12, 13, 14, 16 and 17 are rejected under 35 U.S.C. 101

because they contain within their scope non-statutory embodiments.

As to claims 1, 2, 14 and 17, the physical structure of the claimed server is unclear. The server is comprised of units which may be merely software and not have physical structure. The means cited do not refer to specific physical structure. A server without a physical structure is not statutory under 35 USC 101.

As to claim 6, a method is required to either transform a physical thing into another state or thing, or else to have a substantial method step tied to another statutory class. Claim 6 does not recite a physical transformation nor a substantial method step tied to a secondary statutory class.

It may be useful to the applicant to consider recent decisions that clarify that a nominal mention of an apparatus in the preamble (i.e. "a computer-implemented method comprising") is not sufficient to tie a method claim to a statutory class. Ex Parte Wasynczuck and Ex parte Langemyr (available through http://www.uspto.gov/web/offices/dcom/bpai/informative_opinions.html) provide examples, relying on the established cases Benson, Comiskey and Flook (Benson, 409 U.S. at 71-72, Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Cj, Flook, 437 U.S. at 593).

As to claims 12, 13, and 16, the preamble recites a carrier wave. Carrier waves are not included in the four statutory categories: process, machine, manufacture, or composition of matter. See In re Petrus Nuijten CAFC 2006-1371, which says that

something transient or fleeting cannot constitute a manufacture under 35 USC 101 (1356). In particular, a machine readable medium storing instructions falls under functional descriptive material and requires a physical medium for subject matter eligibility. The computer readable medium must be a tangible physical structure, not merely a signal or carrier wave, which permits the functionality to be realized within the computer. A program product without a physical medium has negligible physical form, and thus is not statutory. A claim that includes within its scope a non-statutory embodiment must be rejected under 35 USC 101.

The dependent claims do not remedy the problems.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 6, 12, 13 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 12, 13, and 16 the specification does not show support for carrier waves.

As to claim 6, the specification does not show support for transmitting an identification number of a system of billing.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-3 and 6-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As above, the physical structure of the server in claims 1, 2, 14 and 17 is unclear. As to claims 1, 2, 6, 8, 9, and 12-17, the phrase "retrieving the system" is unclear. Where is it retrieved from? Where is it retrieved to? What is the retrieved system? How does an element of a server physically move a system? The metes and bounds of the claim are unclear.

As to claim 1, the claim recites a system of billing a user through a network. Is that system a component of the server or something that communicates with it?

As to claim 1, the claim recites a user device from a storage unit, although there is no antecedent for a user device from a storage unit. Retrieving the system from a storage unit is better aligned with the specification but not with the claim language. The metes and bounds of the claim are unclear.

As to claim 1, the claim refers to charge information with a user device. Is this battery charge or billing charge?

As to claim 1, the claim recites performing a payment by the retrieved system. As above, it is unclear what the retrieved system is. It is further unclear how a retrieved system can perform a payment. If the retrieved system is a parking meter, does the parking meter perform the payment?

Claims 2, 6, 8, 9, and 12-17 recite receiving notification request information relating to a timing of notifying the current use information. Generally people are notified of information; the meaning of notifying information is not clear. Further the term "notification request information" is not clear. Is this request related to the other request? Where does it come from? The metes and bounds of the claimed invention are not clear.

Claims 2, 8, 9, and 12-17 recite a request. Where does the request fit into the invention? Where does it come from and where does it go?

Claims 2, 8, 9, and 12-17 recite current use information. Is this related to use of the user device? Or is it use of something else?

As to claims 9 and 13, how can current use information be recorded in advance? The remaining claims listed are rejected as inheriting the problems cited.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application 20020032601 filed 4/25/01 by Admasu et al, in view of US Patent 5974453 filed 10/8/97 by Andersen et al.

As to claim 1, Admasu teaches in paragraphs 14 and 15 , page 2, performing a communicating process with a user device and a system of billing a user through a network for an amount, the amount based on a predetermined total length of time. Admasu does not use the terms charge information nor use information, but clearly indicates sending information that would be in these categories.

Admasu teaches in paragraph 35 page 3 and paragraph 38 on pages 3 and 4 obtaining information requested by the user from the system. In the case of parking, the examiner does not find a patentably distinguishable difference between use information, charge information, and the information cited by Admasu: Amount of payment, time units purchased, time of expiration, and a list of occupied spaces. It would have been obvious to a person of ordinary skill in the art to recombine these elements and present them as charge information or use information; the difference is a minor issue of format, so they are obvious variants. Thus it would have been obvious for a person of ordinary skill in the art at the time of the invention to modify Admasu to explicitly state obtaining charge information or use information requested by the user from the system retrieved by the retrieving process unit. Let this argument be hereafter called "charge/use."

Admasu teaches in paragraph 35 page 3 transmitting the charge information to the user device. Admasu teaches in paragraph 39 page 4 performing a payment by the retrieved system according to a request for payment from the user device.

Admasu does not explicitly teach retrieving the system corresponding to identifying information received from the user device from a storage unit or according to a request. Andersen teaches in col 2 lines 25-50 teach retrieving the system corresponding to identifying information received from the user device from a storage unit according to a request. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Admasu to add retrieving the system corresponding to identifying information received from the user device from a storage unit according to a request in order to take advantage of standardized readily available and proven reliable technology of DNS (domain name service) technology and tools. Let this argument be hereafter called "DNS."

12. Claims 2, 3 and 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admasu et al, in view of Andersen et al. as applied above, and further in view of US Patent Application 2002/0147673 filed 1/31/01 by Allen.

As to claims 2, 8, 9, and 12-17, Admasu teaches in paragraphs 14 and 15 page 2 performing a communicating process with a user device and a system of billing a user through a network for an amount, the amount based on a predetermined total length of time, and also teaches performing a communicating process with a user device through a network.

As to claims 2, 6, 8, 9, and 12-17, Admasu does not teach retrieving the system corresponding to identification information received from the user device or according to a request." Andersen does as above under "DNS." It would have been obvious to a

person of ordinary skill in the art at the time of the invention to modify Admasu to add retrieving the system corresponding to identifying information received from the user device from a storage unit according to a request in order to take advantage of standardized readily available and proven reliable technology of DNS (domain name service) technology and tools.

As to claims 2, 6, 8, 9, and 12-17, Admasu teaches obtaining current use information from the system retrieved by the retrieving processing unit as above under "charge/use."

As to claims 2, 6, 8, 9, and 12-17, Admasu teaches a registration phase in which notification information such as contact information (paragraph 26 page 2) is received into the system. Admasu does not teach receiving notification request information relating to a timing of notifying the current use information. Allen teaches in paragraph 25 page 3 request for timing preferences for notifications through user devices. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Admasu to add receiving notification request information relating to a timing of notifying the current use information in order to allow the user to set contact preferences and avoid annoying the user with undesired contacts.

As to claims 2, 6, 8, 9, 12, 13, and 15-17, Admasu teaches in paragraph 35 page 3 transmitting the obtained use information to the user device according to the notification request information received from the user device.

As to claims 14-16, Admasu teaches in paragraph 39 page 4 performing a payment according to a request for payment from the user device.

As to claims 8, 12, and 17, Admasu teaches in paragraph 39 page 4 performing a payment by communicating with the system of billing a user for up to a predetermined total time. Admasu teaches obtaining charge information from the system through the network as above under "charge/use."

As to claim 6, Admasu teaches in paragraph 42 page 4 transmitting an identification number of a system of billing a user for an amount the amount based on a predetermined total length of time, and user information from a user device.

As to claim 6, Admasu does not teach system addresses. Andersen teaches obtaining system addresses as above under "DNS". It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Admasu to add obtaining an address of a system of billing a user by a predetermined time corresponding to the identification number in order to take advantage of standardized readily available and proven reliable technology of DNS (domain name service) technology and tools. Admasu teaches obtaining use information from the system at the address and providing information, as above under "charge/use".

As to claims 9 and 13, Admasu teaches obtaining current use information from the system, and transmitting the obtained use information to the user device, as under "charge/use." Admasu does not give details of contact preferences, but Allen shows that cell phone contact preferences were old and well-known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Admasu to add to recorded information transmitted in advance from the user device or

at a request from the user device, such as contact preferences, in order to regulate the communication according to the user wishes.

As to claims 15 and 16, Admasu teaches obtaining use information about a user who uses a system of billing a user for an amount, the amount based on a predetermined total length of time as above under "charge/use". Admasu does not address, but Allen paragraph 25 page 3 teaches as above, determining a transmission timing of a message according to the obtained use information, and transmitting the message to the user device through the network with the transmission timing. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Admasu to add determining a transmission timing of a message according to the obtained use information, and transmitting the message to the user device through the network with the transmission timing in order to make the contacts as useful to the user as possible.

As to claim 3 (dependent on 2), Admasu teaches in paragraph 27 pages 2 and 3 the payment is made in a pre-payment system for a predetermined time. Admasu teaches in paragraph 46 page 4 a message is transmitted to the user device at any time before the predetermined time elapses.

As to claims 7, 10 and 11, Admasu teaches in the abstract the system of billing a user by a predetermined time is a parking meter, and the charge is a parking charge for use of the parking meter.

Conclusion

13. While portions of interest have been indicated, all references should be considered for the entirety of their teachings.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL

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